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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,906	06/20/2001	Jozef C.W. Spijkers	108741	7931
25944	7590	12/12/2003		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320				
			EXAMINER SERGEANT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/786,906	SPIJKERS ET AL.	
	Examiner	Art Unit	
	Rabon Sergeant	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 20 August 2003.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8, 17-21 and 23-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-8, 17-21 and 23-25 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

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1. Claims 1-8, 17-21, and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In view of the claimed carbon to oxygen ratio for the polyethylene oxide glycol being from 2.0:1 to 4.3:1, it is unclear if the term, polyethylene oxide glycol, is to encompass polyethers having oxyalkylene groups other than oxyethylene or even excluding oxyethylene. The ratio, as claimed, suggests polyether species, such as polytetramethylene ether glycol; however, this expansion or interpretation of the term, polyethylene oxide glycol, is repugnant to its accepted meaning. Furthermore, it is not clear that applicants have support for such an interpretation.

2. Claims 1-8, 17-21, and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As aforementioned, applicants have failed to reconcile the term, polyethylene oxide glycol, with the claimed carbon atom to oxygen atom ratio.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-8, 17-21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 9-157409 in view of Tanaka et al. ('928).

The primary reference discloses water vapor permeable polyurethane films, suitable for use in apparel and medical applications, having moisture vapor transmission rates of greater than 5000 g/m²-24 hours, wherein the polyurethane films are derived from the reaction of a polyisocyanate, such as diphenylmethane diisocyanate, a polyoxyethylene glycol having a molecular weight of 500-5,000 and inherently having an atomic ratio of carbon to oxygen of about 2:1 (since the oxyethylene group contains two carbon atoms and one oxygen atom), and a chain extender, such as butanediol, in amounts that overlap the amounts claimed by applicants. See the Detailed Description within the computer translation provided by the Japanese Patent Office.

5. The primary reference is silent with respect to the use of the instantly claimed araliphatic diol component; however, the incorporation of an araliphatic diol corresponding to that claimed within polyurethane compositions was known at the time of invention. Tanaka et al. disclose that the use of the araliphatic diol within polyurethane formulations is beneficial for controlling tackiness or stickiness. See columns 1 and 2 within Tanaka et al.

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6. Within page 1 of the specification, applicants have disclosed that an inherent deficiency associated with the high polyethylene oxide content, moisture vapor permeable films of JP 9-157409 is high tackiness. Therefore, since it has been held that it is obvious to utilize a known component for its known function (*In re Linder*, 173 USPQ 356; *In re Dial et al.*, 140 USPQ 244), the position is taken that one of ordinary skill would have been motivated to incorporate the araliphatic diol into the composition of the primary reference, so as to control tackiness, as well as other properties, of the water vapor permeable films.

7. A computer translation of the Claims and Detailed Description of JP 9-157409, supplied by the Japanese Patent Office, is being supplied with this Office action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

December 7, 2003